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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/699,716	08/27/1996	DAVID G. HEATH	003/029/SAP	3555

7590

11/28/2003

MCMR SGRD-JA

US Army MPMC

504 Scott Street

Fort Detrick, MD 21702-5012

EXAMINER

DUFFY, PATRICIA ANN

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 11/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/699,716

Applicant(s)

Heath et al.

Examiner

Duffy

Group Art Unit

1645

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8-22-03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 5, 7-17, 31 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-3, 5, 7-10, 12-17, 31 is/are allowed.
- ☒ Claim(s) 11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Continued Examination Under 37 CFR 1.114

1. The response filed 8-22-03 has been entered into the record. Claims 1, 2, 3, 5, 7-17 and 31 are pending. Claims 1-3, 5, 7-1012-17 and 31 are allowed. Claim 11 is under examination.
2. The text of Title 35 of the U.S. Code not reiterated herein can be found in the previous office action.
3. The rejection of claim 11 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is maintained for all reasons previously made of record and reasons recited herein.

The issue of record is the deposit, after filing of a specifically claimed construct, "pF1V". Applicants argue that the deposit record provided and the removal assurances provided obviate the rejection of record. This is not persuasive, first because the deposit record provided does not indicate or name the deposited plasmid pF1V. The deposit rules require that which is deposited be the same that is described in the specification as filed. There is no written description of any plasmid by the name of pMF1-V731, BL21/DE3 in the specification and moreover this is not the claimed plasmid. There must be correlation between the description of the plasmid in the specification and that which was deposited see MPEP 2406.01. The statement by Applicants representative that it is the same as described is not persuasive. Additionally, the response lacks corroboration as set forth in MPEP 2406.02 for deposits made after the filing date. "When the original deposit is made after the effective filing date of an application for patent, an applicant is required to promptly submit a statement from a person in a position to corroborate that the biological material which is deposited is a biological material specifically identified in the application (the filing date of which is relied upon) as filed. The nature of this corroboration will depend on the circumstances in the particular application under consideration, including the length of time between the application filing date and the date of deposit. For these reasons, the deposit form is insufficient to obviate the rejection.

Status of Claims

4. Claim 11 stands rejected. Claims 1, 2, 5, 7-10, 12-17 and 31 are allowed.

Conclusion

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy, Ph.D. whose telephone number is (703) 305-7555. The examiner can normally be reached on Monday-

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Thursday and Saturday from 10:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached at (703) 308-3909.

Patricia A. Duffy, Ph.D.
November 26, 2003

Pat A. Duffy
Patricia A. Duffy, Ph.D.
Primary Examiner
Group 1600